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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,948	09/27/2001	James P. VanLaeken	36-01-P10F	4607

7590
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09/24/2002

EXAMINER

BELL, KENT L

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 09/24/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,948

Applicant(s)

van LAEKEN

Examiner

KENT L. BELL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on application filed 9/27/01
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

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No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. The disclosure is objected to under 37 CFR 1.121(e) because the Latin name of the genus and species of the claimed plant and Variety Denomination of the claimed plant should be preceded by a heading as set forth in 37 CFR 1.163(c)(4)(5) and 37 CFR 1.163(d). This information should be set forth before the **"BACKGROUND OF THE NEW VARIETY"** section as set forth in 37 CFR 1.163(c).

B. Applicant should set forth in the specification the Genus and species for the instant plant, to the extent known, as set forth in "A" above.

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C. Page 1, lines 9-12, Applicant has stated how the instant plant was asexually reproduced but has not stated where the asexual reproduction took place. Applicant should set forth in the specification where the asexual propagation took place (MPEP 1605).

D. Page 1, lines 18 and 21, page 2, lines 4, 5, 6, 8, and 9, page 4, lines 15, 17, and 18, page 5, lines 1 and 11, and abstract, lines 4 and 5, Applicant states "petals", "petal", and "petals" respectively. When describing clematis flower characteristics the proper botanical term --tepal-- or --tepals-- is used in place of the term "petal" or "petals". As such, applicant should delete the "petal/petals" recitations and replace them with either --tepal-- or --tepals--, whichever is appropriate.

E. Page 2, lines 16 and 17, Applicant should set forth in the specification the age of the plants when described and container size, if grown in a container.

F. Applicant should set forth in the specification the typical and observed plant diameter/spread.

G. Page 3, line 2, Applicant states leaf size is "medium". Applicant should set forth in the specification the typical and observed leaf size including the length and width of a simple leaf,

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length and width of a compound leaf, and the length and width of the individual leaflets. The recitation "medium" is vague and meaningless in this instance.

H. Page 3, line 3, Applicant states leaf quantity is "average". Applicant should set forth in the specification the typical and observed number of leaves per plant or per stem. The recitation "average" is vague and meaningless in this instance.

I. Page 3, line 4, Applicant has set forth a color designation for the leaves but has not specified whether the color designation represents the upper, lower, or both surfaces. Applicant should set forth a color designation(s) for both surfaces in the specification. Color designation(s) should be referenced by the employed color chart.

J. Page 3, lines 5 and 6, Applicant provides a shape for the leaflets but has not provided a shape for a simple leaf. Applicant should set forth in the specification a typical and observed shape for a simple leaf.

K. Page 3, line 8, Applicant should set forth in the specification additional information relative to the instant plant's petioles including the typical and observed length and diameter. Further, applicant states petiole color is "green/red". Applicant should set forth in the

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specification a color designation(s) for the "green/red" coloration(s). The recitation "green/red" is vague and meaningless in this regard.

L. Page 3, lines 9-13, Applicant provides information relative to the instant plant's internodes and disease. It appears these two characteristics should be set forth under different subheadings, one other than the foliage subheading. It appears the internode description would be better located under the Wood subheading, describing the internode length for the new shoots and old wood, as set forth on lines 14-20 of the same page. It appears the Disease information would be better located under it's own subheading, i.e. F. Disease....., after line 21 of the same page.

M. Page 3, lines 9 and 10, Applicant states an internode is "cylindrical" and is approximately from "5 inches to about 8 inches". It is uncertain what the measurement set forth is describing as applicant has stated "cylindrical". Applicant should clarify the recitation above and set forth in the specification the typical and observed internode length as set forth in "L" above.

N. Page 3, lines 11-13, In addition to the Disease information set forth, applicant should set forth in the specification meaningful information relative to the instant plant's resistance/susceptibility to pests.

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O. Page 3, lines 16 and 19, Applicant states new shoot color is "light green" turning "deep red/purple". Applicant further states old wood color is "light brown". Applicant should set forth in the specification a color designation(s) for the "light green", "deep red/purple", and "light brown" coloration(s). The recitations "light green", "deep red/purple", and "light brown" are vague and meaningless in this regard.

P. Page 4, line 5, Applicant set forth a bud size but does not state whether the dimension set forth is for the length or diameter or other. Applicant should set forth in the specification the typical and observed bud length and diameter.

Q. Page 4, line 7, Applicant states bud color is "green/grayish white". Applicant should set forth in the specification a color designation(s) for the "green/grayish white" coloration(s). The recitation "green/grayish white" is vague and meaningless in this regard.

R. Page 4, line 12, Applicant states stem color is "green" turning "red/purple" with age. Applicant should set forth in the specification a color designation(s) for the "green" and "red/purple" coloration(s). The recitations "green" and "red/purple" are vague and meaningless in this regard.

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S. Page 4, line 14, Applicant sets forth a bloom size but does not set forth whether the measurement set forth is for the diameter, depth, or other. Applicant should set forth in the specification the typical and observed bloom diameter and depth.

T. Page 4, lines 17-19, Applicant has set forth a color designation for the tepals but has not specified whether the color designation represents the upper, lower, or both surfaces. Applicant should set forth a color designation(s) for both surfaces in the specification. Color designation(s) should be referenced by the employed color chart. In addition, applicant should set forth in the specification a color designation(s) for the "white" coloration. The recitation "white" is vague and meaningless in this regard.

U. Page 4, lines 22 and 23, Applicant states quantity of blooms is very floriferous because of the multiple buds formed on each stem. Applicant should quantify "very floriferous" by setting forth in the specification either the typical and observed quantity of flowers/buds per plant or the typical and observed number of flower stems per plant with the typical and observed number of flowers/buds per stem.

V. Page 5, lines 1-5, Applicant should set forth in the specification additional information relative to the instant plant's tepals including the typical and observed tepal apex, base, and

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margin descriptors, length, and width in the interest of providing as complete a botanical description of the plant as is reasonably possible.

W. Page 5, lines 6-16, Applicant should set forth in the specification additional information relative to the instant plant's reproductive organs including the typical and observed pistil number.

X. Page 5, lines 12 and 13, Applicant should set forth the typical and observed amount of pollen produced per flower, i.e. scarce, moderate, abundant.

Y. Applicant should set forth in the specification the typical and observed lastingness of an individual bloom on the plant and as a cut flower.

Z. Applicant should set forth information in the specification relative to the instant plant's fruit and/or seeds, if produced, such as the typical and observed amount, size, and coloration. Color designation(s) should be referenced by the employed color chart.

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The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Comments

Due to the amount of revision seen necessary in this application, it is suggested that Applicant file a substitute specification, incorporating all additions, deletions and modifications so as to provide the printer a clean copy at the time of allowance. Applicant should specifically authorize cancellation of the present specification to the same. Further, a clean copy and marked up copy (showing any addition, deletion, and/or modification) of the substitute specification should be submitted.

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Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (703) 306-3224. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

KENT L. BELL
PATENT EXAMINER

Kent L. Bell